IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Kalush et al. Art Unit: 1646

Serial No.: 09/768,185 Examiner: J. Murphy

Filed: Jan. 24, 2001 Atty. Docket: CL000280

For: ESTROGEN RECEPTOR BETA VARIANTS AND METHODS OF DETECTION THEREOF

#13
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9/26/02

Response to Restriction Requirement

Assistant Commissioner for Patents
Washington, D.C. 20231

By Facsimile

Sir:

This is in response to the Office Communication mailed July 25, 2002 in which a restriction requirement was issued for the above referenced application. Please charge the petition for a one-month Extension of Time to Deposit Account 50-0970.

In the Office Communication, the Examiner states that "applicant has instead presented four separate nucleic acid sequences containing mutations in SEQ ID NO: 1, each of which is a separate invention." Therefore, the Examiner requested the election of one nucleic acid sequence containing one mutation in SEQ ID NO: 1, according to the claims submitted in the preliminary amendment.

In response, Applicants hereby elect the group containing nucleic acid sequence with a 'T' at position 89837 of SEQ ID NO: 1. Thus, the elected claims are claims 18-21 and 26, 27 and 32.

However, Applicants request the reconsideration of the restriction because the claims are drawn to a nucleic acid molecule having single nucleotide polymorphisms (SNPs) at four different positions in SEQ ID NO:1, which is a single invention. Because SNPs in SEQ ID NO:1 are synonymous codons/silent mutations, the amino acid sequence encoded by SEQ ID NO:1 does not change. Therefore, these sequences will only encode ONE polypeptide. MPEP section 2434 specially states, "Nucleotide sequences encoding the same protein are not considered to be independent and distinct and will continue to be examined together."

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Further, Applicants respectfully request that the Examiner reconsider the claim division between the nucleic acid and the use of the nucleic acid. Specifically, the point of novelty of the nucleic acid is the SNPs present at four different nucleotide positions, which can be used for detection and other purposes. These SNPs provide uses (e.g., methods of detecting and identifying risk of estrogen receptor related diseases) of the subject matter and it is believed that examination of these claims would not unduly burden the Examiner with additional review issues.

In view of the above, Applicants respectfully request the Examiner withdraw the restriction requirement mailed in the Office Communication.

Respectfully submitted,

CELERA GENOMICS

Date: September 25, 2002

By: _____

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